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Paper No. 16
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re British-American Tobacco (Holdings) Limited

Serial No. 75/475,767

Kathleen E. McCarthy, Maren Coburn and Charles P. Guarino
of Morgan & Finnegan, LLP for British-American Tobacco
(Holdings) Limited.

Tina L. Snapp, Trademark Examining Attorney, Law Office 103
(Thomas G. Howell, Managing Attorney).

Before Simms, Hairston and Bottorff, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

British-American Tobacco (Holdings) Limited has filed
an application to register the mark shown below,

for "direct mail advertising and advertising agency services, namely, promoting the goods and services of others through the distribution of printed materials and by rendering sales promotion advice."¹

The Trademark Examining Attorney has finally refused registration on the ground that applicant has failed to comply with the requirement for a disclaimer, under Section 6(a) of the Trademark Act, of the phrase "BRITISH AMERICAN." Applicant has volunteered to disclaim separately the words "BRITISH" and "AMERICAN," arguing that the record fails to demonstrate that "'British American' is a unitary geographically descriptive phrase in the context of the mark and services at issue here." (Reply brief, p. 1).

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but no oral hearing was requested.

It is the Examining Attorney's position that although "BRITISH AMERICAN" does not name an actual geographic place, it is nonetheless geographically descriptive matter

¹ Serial No. 75/475,767, filed on April 28, 1988, based upon applicant's allegation of a bona fide intention to use the mark in commerce. The word "TOBACCO" has been disclaimed apart from the mark as shown.

and therefore it must be disclaimed as a unitary phrase. The Examining Attorney maintains that the requirement for a disclaimer of the unitary phrase "BRITISH AMERICAN" is consistent with Office practice and relies on third-party registrations for composite marks wherein such terms as "Chinese American," "Iranian American," "African American," "West Indian American," "Lebanese American," and "German American" have been disclaimed.

Applicant, in urging reversal of the refusal to register, makes a number of arguments. First, applicant argues that the evidence made of record by the Examining Attorney does not support her contention that the term "British American" is primarily geographically descriptive. However, in an earlier case having analogous facts, the Board dealt with a similar issue:

[T]he basis for applicant's position is that when combined in the phrase LONDON & EDINBURG, the individual geographic terms become nongeographic because London & Edinburgh is not the name of a particular geographic place. We disagree. When the mark LONDON & EDINBURGH INSURANCE is viewed as a whole, the geographic significance of the words is not lost. Consumers will still regard the mark as referring to the cities of London and Edinburgh, rather than to some mythical place called "London & Edinburgh." Nor can London & Edinburgh be considered

such an odd or incongruous combination of geographic place names that consumers will view it as an arbitrary combination without a geographic significance as a whole"

Further, applicant argues that purchasers and prospective purchasers who see its BRITISH AMERICAN TOBACCO and design mark in connection with the identified services will not assume that "British America" is a geographical place. However, our decision does not turn on the existence of a mythical place called "British America." Rather, we conclude that purchasers and prospective purchasers will regard the combined words BRITISH AMERICAN in applicant's mark as having primarily geographic significance. The NEXIS evidence supports the conclusion that this is a combination that purchasers are quite accustomed to seeing since it is used in the media. Moreover, this geographical significance is not lost with the addition of the word "TOBACCO" to "BRITISH AMERICAN," or because the word "tobacco" is arbitrary for the identified services. That this entire composite also happens to be part of applicant's logo, contains its trade name and constitutes a critical component of its corporate identity is largely irrelevant to the question of whether BRITISH AMERICAN is primarily geographical.

With respect to the third-party registrations made or record by the Examining Attorney for marks containing "_____ AMERICAN, we note that the vast majority of these registrations cover non-profit enterprises and service organizations. We agree with applicant they are not totally analogous and hence are of limited value in reaching our decision herein.

Additionally, we agree with applicant that its disclaimer of the term "BRITISH AMERICAN" in a prior registration for tobacco is not binding on applicant in the instant application for services. However, irrespective of the goods/services involved, it does support the Examining Attorney's contention that in the past, the Office has considered the designation "BRITISH AMERICAN," like other "_____ AMERICAN" terms, to be primarily geographical - a determination totally apart from whether the current record supports a finding of geographical descriptiveness for particular services.

Finally, we turn to the question of how exactly the disclaimer must read in this case. In a similar case, the Board held that:

Petitioner's request for entering two separate disclaimers of "glass" and "technology" in the uniform wording is inappropriate. To allow two separate disclaimers of the individual words in the standard printing format would effectively

permit piecemeal disclaimers of a unitary, descriptive term. Disclaimers of individual components of complete descriptive phrases are improper. In re Surelock Mfg. Co., 125 USPQ 23 (TTAB 1960). Unitary expressions should be disclaimed as a composite. American Speech-Language-Hearing Assn. v. National Hearing Aid Society, 224 USPQ 798 (TTAB 1984). "Glass Technology" is a unitary phrase which is descriptive of the automobile windshield repair kits. Therefore, the wording must be disclaimed in the composite. Separate disclaimer of the individual words, "glass" and "technology," in the standard printing format is improper.

In re Wanstrath, 7 USPQ2d 1412 (Comm'r 1987).

Consistent with these reported decisions, long-standing Office practice has required that unitary phrases be disclaimed in their entirety. Accordingly, the Trademark Examining Attorney was correct is to require a disclaimer of the unitary phrase BRITISH AMERICAN.

Decision: The requirement, under Section 6 of the Trademark Act, for a disclaimer of BRITISH AMERICAN is affirmed. Nonetheless, this decision will be set aside and applicant's mark published for opposition if applicant, no later than thirty days from the mailing date hereof, submits an appropriate disclaimer of BRITISH AMERICAN.